UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,901	07/05/2001	Jeffrey Norris	5793.3055-00	1420

22852   7590   03/22/2007
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EXAMINER
LASTRA, DANIEL

ART UNIT	PAPER NUMBER
3622	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

		Application No.	Applicant(s)
Office Action Summary		09/897,901	NORRIS, JEFFREY
		Examiner	Art Unit	
		DANIEL LASTRA	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>20 December 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-6,8-41,43-76 and 78-112</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-6,8-41,43-76 and 78-112</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-6, 8-41, 43-76 and 78-112 have been examined. Application

09/897,901 has a filing date 07/05/2001.

Response to Amendment

2.   In response to an Non Final Rejection filed 06/20/2006, the Applicant filed a

Request for Reconsideration on 12/20/2006.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed
> or described as set forth in section 102 of this title, if the differences between the
> subject matter sought to be patented and the prior art are such that the subject
> matter as a whole would have been obvious at the time the invention was made
> to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was
> made.

Claims 1-9, 14-44, 49-79 and 84-105 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Gardenswartz et al (U.S. 6,055,573) in view of Scroggie (US

5,970,469).

As per claims 1, 36, 71 and 112, Gardenswartz teaches:

A method for providing a purchase transaction incentives using a financial

product having an identification code that may be scanned at a point-of-sale terminal,

the method comprising:

tracking a purchase transaction by a first consumer based on identification data

obtained from scanning of the identification code on the financial product (see column 5,

lines 44-60; column 4, lines 12-25);

receiving data relating to the transaction and receiving identification data relating

to the identification code for storage in a transaction database (see column 6, lines 5-

25);

providing, the purchase transaction incentive based on the stored data relating to

the transaction and the stored identification data relating to the identification code,

wherein the purchase transaction incentive provides an incentive to the first consumer

to make a future purchase (see column 4, lines 12-25).

Gardenswartz fails to teach determining whether the first consumer corresponds

to a geographic zone that is associated with the purchase transaction incentive and

providing, when it is determined that the first consumer corresponds to the geographic

zone, the purchase transaction incentive. However, Scroggie teaches a system that

transmits back to customers a plurality of incentive offers based upon said customer

geographic region or zone (i.e. "zip code") (see column 1, lines 50-55; column 3, lines

25-30). Therefore, it would have been obvious to a person of ordinary skill in the art at

the time the application was made, to know that Gardenswartz would use a customer's

geographical location and transaction data (see Scroggie column 12, lines 64-67) to

target purchase incentives to said customer, as taught by Scroggie. This feature would

allow advertisers to target incentives to a customer that is exercisable in the customer's

geographic location, therefore, increasing the probability that said customer would redeem said incentive.

Gardenswartz teaches:

wherein providing the purchase transaction incentive further includes:

determining attributes of a first group of consumers in a market population of consumers who have purchased an item, wherein the market population of consumers is based on the stored transaction data (see Gardenswartz column 12, lines 29-56);

and wherein at least one of the attributes includes at least one of:

financial information associated with the first group of consumers including at least one of: primary payment type or bad check indicator, or information relating to bad checks; or

loyalty information associated with the first group of consumers including at least one of history of responses to loyalty offers, age, gender, or marital status (see Gardenswartz column 4, lines 5-10; col 15, lines 20-40 "offering value contracts). Gardenswartz teaches classifying consumers by assigning to the consumer a purchase behavior group classification (see Gardenswartz col 3, lines 45-55, col 12, lines 35-45), where said purchase behavior classification is based upon consumers responses to loyalty offers (see Gardenswartz col 17, lines 20-67) and where targeted advertisements (e.g. value contracts) is selected based on the purchase behavior group classification assigned to the consumer (see Gardenswartz col 17, lines 45-65).

determining attributes of a second group of consumers in the market population of consumers who have not purchased the item and determining differences between

the first group of consumers and the second group of consumers to identify attributes of consumers exhibiting a particular buying behavior (see Gardenswartz column 15, lines 1-40; Gardenswartz identifies attributes of consumers exhibiting a desired buying behavior by identifying consumers' brand preferences); and

providing the purchase transaction incentive to the first consumer based on the first consumer being associated with the identified attributes (see Gardenswartz column 15, lines 40-55).

As per claims 2, 37 and 72, Gardenswartz teaches:

The method of claim 1, wherein the transaction data received from tracking the purchase transaction identify at least one of the items purchased, a merchant associated with the purchase, or the time the first consumer made the purchase (see column 5, lines 60-67).

As per claims 3, 38 and 73, Gardenswartz teaches:

The method of claim 1, wherein the identification code identifies the first consumer (see column 8, lines 33-36).

As per claims 4, 39 and 74, Gardenswartz teaches:

The method of claim 1, wherein receiving the transaction data and the identification data further includes:

associating the transaction data with the identification data for the purchase transaction and storing the transaction data and the identification data in the transaction database based on the association between the transaction data and the identification data (see column 6, line 54 – column 7, line 25).

As per claims 5, 40 and 75, Gardenswartz teaches:

The method of claim 1, wherein providing the purchase transaction incentive further includes:

selecting a subset of the stored transaction data based on predetermined market criteria describing the market population of consumers (see column 12, lines 57-65), Gardenswartz describes in column 12, lines 57-65 that the registration server identifies a subset of the total number of consumers to be analyzed in the purchase transaction database) ;

associating the selected subset of the stored transaction data with the first consumer based on the stored identification data and providing the purchase transaction incentive to the first consumer based on the first consumer being associated with the selected subset of the stored transaction data (see column 12, lines 29-64). Gardenswartz identifies a subset of the total number of transaction data (see column 12, lines 60-65) and uses said subset to classify a consumer into different purchase behavior classifications (see column 13, lines 1-5).

As per claims 6, 41 and 76, Gardenswartz teaches:

The method of claim 5, wherein the predetermined market criteria corresponds to selected transaction data stored in the transaction database (see column 12, lines 29-56).

As per claims 8, 43 and 78, Gardenswartz teaches:

The method of claim 1, wherein the attributes of the first and second group of consumers are included in the stored transaction data (see column 15, lines 1-40).

As per claims 9, 44 and 79, Gardenswartz teaches:

The method of claim 1, wherein providing a purchase transaction incentive further includes:

providing incentives to consumers in the second group of consumers (see column 16, lines 15-36).

As per claims 14, 49 and 84, Gardenswartz teaches:

The method of claim 5, wherein providing the purchase transaction incentive further includes:

providing a plurality of purchase transaction incentives to the market population of consumers; but does not expressly teach and ranking each purchase transaction incentive based on the success of the purchase transaction incentive. However, Gardenswartz teaches in column 16, line 59 – column 17, line 19 teaches that the registration server determines whether a new purchase incentive should be offered to consumers who were offered the original purchase incentive based upon the response of said consumer to the original incentive. Therefore, it would have been to a person of ordinary skill in the art at the time the application was made, to know that because Gardenswartz determines the effectiveness of incentive offers, Gardenswartz would use said determination to rank said purchase incentive offers in the degree that would encourage a customer to continue to engage in desirable behavior and/or change undesirable behavior (see Gardenswartz column 17, lines 35-41).

As per claims 15, 50 and 85, Gardenswartz teaches:

The method of claim 14, wherein ranking the purchase transaction incentive further includes:

associating stored transaction data with consumers who were provided the purchase transaction incentive based on the identification data (see column 18, lines 55-67);

analyzing the associated transaction data to determine whether the first consumer purchased the item associated with the purchase transaction incentive and ranking the purchase transaction incentive based on the determined purchases of the item (see column 17, lines 19-44).

As per claims 16, 51 and 86, Gardenswartz teaches:

The method of claim 14, wherein providing the purchase transaction incentive further includes: providing to the first consumer the highest ranked purchase transaction incentive (see column 15, lines 1-40; column 17, lines 5-15). Gardenswartz teaches in column 16, line 59 – column 17, line 19 teaches that the registration server determines whether a new purchase incentive should be offered to consumers who were offered the original purchase incentive based upon the response of said consumer to the original incentive. Therefore, it would have been to a person of ordinary skill in the art at the time the application was made, to know that because Gardenswartz determines the effectiveness of incentive offers, Gardenswartz would use said determination to rank said purchase incentive offers and would transmit a customer the highest ranked purchase transaction incentive that would encourage said customer to continue to

engage in desirable behavior and/or change undesirable behavior (see Gardenswartz column 17, lines 35-41).

As per claims 17, 52 and 87, Gardenswartz teaches:

The method of claim 1, wherein the transaction is at least one of a credit card transaction, a cash tender transaction, or a check tender transaction (see column 5, lines 44-60).

As per claims 18, 53 and 88, Gardenswartz teaches:

The method of claim 17, wherein the transaction is a credit card transaction using a credit card other than the credit card with the identification code (see column 5, lines 44-67).

As per claims 19, 54 and 89, Gardenswartz teaches:

The method of claim 1, wherein the purchase transaction incentive comprises a discount for an offered item (see column 14, lines 50-67).

As per claims 20, 55 and 90, Gardenswartz teaches:

The method of claim 1, wherein providing the purchase transaction incentive further includes:

associating the stored transaction data with at least one particular consumer based on the stored identification data and providing the incentive to the at least one particular consumer based on the transaction data associated with the particular consumer (see column 10, lines 24-34).

As per claims 21, 56 and 91, Gardenswartz teaches:

The method of claim 20, wherein providing a purchase transaction incentive further includes:

issuing to the at least one particular consumer reward points that may be used in a rewards point redemption program (see column 14, lines 50-67).

As per claims 22, 57 and 92, Gardenswartz teaches:

The method of claim 20, wherein providing a purchase transaction incentive further includes:

providing to the at least one particular consumer credit enhanced shopping opportunities (see column 14, lines 50-67).

As per claims 23, 58 and 93, Gardenswartz teaches:

The method of claim 20, wherein providing a purchase transaction incentive further includes:

providing to the first consumer an advertisement to purchase an item (see column 14, lines 50-67).

As per claims 24, 59 and 94 Gardenswartz teaches:

The method of claim 20, but does not expressly teach further including:

using the identification code to facilitate a return of a purchased item to a merchant. However, Official Notice is taken that it is old and well known that merchants use customers' identification codes to link purchased items to customers, therefore, facilitating the return of the purchased items. This feature would not patentably distinguish the claimed invention from the prior art.

As per claims 25, 60 and 95, Gardenswartz teaches:

The method of clam 1, wherein the identification code identifies the first consumer as belonging to a predefined group of consumers that may receive discounts when transacting with a participating retailer (see column 12, lines 29-56; column 16, lines 37-45).

As per claims 26-30, 61-65 and 96-100 Gardenswartz teaches:

The method of claim 1, but fails to teach wherein tracking a purchase transaction by a consumer further includes: determining whether the first consumer is eligible for an instant purchase transaction incentive; providing an instant purchase transaction incentive at the point-of-sale terminal; wherein the instant purchase transaction incentive comprises an instant coupon; wherein the instant purchase transaction incentive comprises a percentage discount and wherein the instant purchase transaction incentive comprises a rebate. However, Scroggie teaches a system where customers receive automatically an appropriate discount when said customers present an identification number at a checkout terminal (see Scroggie column 11, lines 55-65; column 2, lines 54-65; column 6, lines 9-12). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Gardenswartz would target purchase incentive to customers, which would be automatically redeemable at a point of sale terminal, as taught by Scroggie. This feature would expedite the redemption of incentive offers at checkout terminals.

As per claims 31, 66 and 101, Gardenswartz teaches:

The method of claim 1, wherein the identification code is at least one of a bar code, a numeric code, a digital code, a visual code, or a magnetic code (see column 5, lines 44-60).

As per claims 32, 67 and 102, Gardenswartz teaches:

The method of claim 1, wherein the transaction data describes an item purchased by the first consumer (see column 6, lines 5-25).

As per claims 33, 68 and 103, Gardenswartz teaches:

The method of claim 1, wherein the transaction data describes when the first consumer purchased an item (see column 16, lines 36-50).

As per claims 34, 69 and 104, Gardenswartz teaches:

The method of claim 1, wherein the transaction data describes where the first consumer purchased an item (see column 16, 34-50).

As per claims 35, 70 and 105, Gardenswartz teaches:

The method of claim 1, wherein the transaction data describes a method of payment with which the first consumer purchased an item (see column 5, lines 44-67).

4.   Claims 10-13, 45-48 and 80-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz et al (U.S. 6,055,573) in view of Scroggie (US 5,970,469) and further in view of Wexler (US 5,960,409).

As per claims 10, 45 and 80, Gardenswartz teaches:

The method of claim 5, but fails to teach wherein providing the purchase transaction incentive further includes:

selecting a marketing channel for providing the purchase transaction incentive to

the market population of consumers and evaluating the success of the purchase transaction incentive, as provided, through the marketing channel, based on the stored transaction data. However, <u>Wexler</u> teaches a system that allows advertisers to compare the effectiveness of each of the publishing sites that advertises said advertisers' promotions (see <u>Wexler</u> column 5, line 45 – column 6, line 10). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that <u>Gardenswartz</u> would target promotions to consumers (see <u>Gardenswartz</u> column 20, lines 15-17) and would use the <u>Wexler</u> system to compare the effectiveness of each of the publishing sites (i.e. marketing channels) that advertises said advertisers' promotions (see <u>Wexler</u> column 5, lines 24-45). Advertisers would like to advertise in at more than one location and the <u>Wexler</u> system would allow said advertisers to determine the best location to advertise said advertisers' promotions.

As per claims 11, 46 and 81, <u>Gardenswartz</u> teaches:

The method of claim 10, wherein evaluating the success of the purchase transaction incentive further includes:

associating stored transaction data with consumers who were provided the purchase transaction incentive based on the identification data (see column 6, lines 54-67);

analyzing the associated transaction data to determine whether the first consumer purchased the item associated with the purchase transaction incentive (see column 6, lines 55-67); and

evaluating the success of the purchase transaction incentive based on the determined purchases of the item (see column 17, lines 45-67).

As per claims 12, 13, 47, 48 and 82-83, Gardenswartz teaches:

The method of claim 10, but fails to teach wherein providing the purchase transaction incentive further includes:

selecting a plurality of marketing channels for providing the purchase transaction incentive to the market population of consumers and ranking each marketing channel based on the success of the purchase transaction incentive as provided through that marketing channel and wherein providing the purchase transaction incentive further includes providing the purchase transaction incentive using the highest ranked marketing channel. However, Wexler teaches a system that allows advertisers to compare the effectiveness of each of the publishing sites that advertises said advertisers' promotions (see Wexler column 5, line 45 – column 6, line 10). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Gardenswartz would target promotions to consumers (see Gardenswartz column 20, lines 15-17) and would use the Wexler system to compare the effectiveness of each of the publishing sites (i.e. marketing channels) that advertises said advertisers' promotions (see Wexler column 5, lines 24-45). Advertisers would like to advertise in at more than one location and the Wexler system would allow said advertisers to determine the best location to advertise said advertisers' promotions.

5.   Claims 106-111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz et al (U.S. 6,055,573) in view of Scroggie (US 5,970,469) and further in view of Walker (US 5,945,653).

As per claims 106-111, Gardenswartz teaches

The method of claim 1, but fails to teach wherein providing a purchase transaction incentive further includes: inserting the purchase transaction incentive into a credit card statement and providing a coupon with a monthly credit card statement. However, Walker teaches providing a coupon with monthly credit card statement (see figure 9). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Gardenswartz would provide coupons with monthly customer's credit card statements, as taught by Walker for the purpose of encouraging said customers to use more said credit card.

Response to Arguments

6.   Applicant's arguments filed 12/20/2006 have been fully considered but they are not persuasive. The Applicant argues that Gardenswartz does not teach the claimed step of "determining" attributes of a first group of consumers, wherein at least one of the attributes includes at least one of "financial information" or "loyalty information" associated with the first group of consumers, as defined by claim 1. The Examiner answers that Gardenswartz teaches classifying consumers by assigning to the consumer a purchase behavior group classification (see Gardenswartz col 3, lines 45-55, col 12, lines 35-45), where said purchase behavior classification is based upon consumers responses to loyalty offers (see Gardenswartz col 17, lines 20-67) and

where targeted advertisements (*e.g.* value contracts) is selected based on the purchase behavior group classification assigned to the consumer (see <u>Gardenswartz</u> col 17, lines 45-65). Therefore, contrary to Applicant's argument, <u>Gardenswartz</u> teaches "determining" attributes of a first group of consumers, wherein at least one of the attributes (*i.e.* purchase behavior classification) includes at least one of "financial information" or "loyalty information", where said "loyalty information" includes at least one history of responses to loyalty offers.

Conclusion

7.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
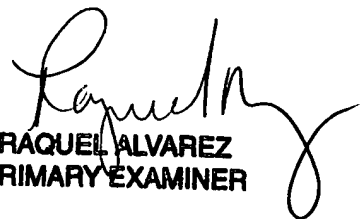
Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Lastra
March 8, 2007

RAQUEL ALVAREZ
PRIMARY EXAMINER